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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,299	10/09/2001	Yoshiya Gunji	212289US0PCT	4922

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EXAMINER

STEADMAN, DAVID J

ART UNIT PAPER NUMBER

1656

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 09/926,299	<b>Applicant(s)</b> GUNJI ET AL.	
	<b>Examiner</b> David J. Steadman	<b>Art Unit</b> 1656	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 15 December 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment. (See 37 CFR 1.116 and 41.33(a)).

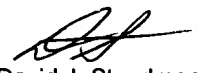
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: \_\_\_\_\_.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: 1,2,5,7-10,12,13,16,17,20,21 and 26-31.  
 Claim(s) withdrawn from consideration: 14,15,18,19 and 22-25.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.  
 12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). 12/15/05  
 13. ☐ Other: \_\_\_\_\_.

  
 David J. Steadman, Ph.D.  
 Primary Examiner  
 Art Unit: 1656

### ADVISORY ACTION

[1] The request for reconsideration in the response filed on 12/15/2005 has been considered, however the amendment does not place the application in condition for allowance. While the amendment would appear to overcome the rejections under 35 U.S.C. §§ 112, second paragraph, and 102(b) as set forth at ¶¶ [10] and [13] of the Office action mailed on 9/16/2005, the amendment to the claims has not been entered because the claims as amended raise a new issue requiring further consideration and/or search. See MPEP § 714.13 regarding non-entry of an after-final amendment.

[2] Certain claims have been amended to recite “a protein...encoded by the DNA sequence comprising” specific nucleotides of a sequence identifier. See, e.g., part b) of claim 1, which states, “a protein...encoded by the DNA sequence comprising nucleotide numbers 1268 to 2155 of SEQ ID NO:9.” A skilled artisan would recognize that, in view of the transitional phrase “comprising,” the recited DNA can include additional nucleotides at its 5'- and 3'-ends. Thus, the above referenced term encompasses numerous DNAs. However, it is unclear as to *the* DNA sequence of the numerous DNAs that is specifically referenced by the claim. Consequently, it is unclear as to the scope of proteins that are encompassed by the claims.

[3] Also, it is noted that certain claims have been amended to recite “except that substitution, deletion, addition, or inversion of one to 10 amino acids” is present.” See, e.g., claim 16. Prior to the instant amendment, the number of variations was unlimited as fully explained in the prior Office action (see p. 11, lines 8-11 of the 9/16/2005 Office

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action). Because the variation in the protein sequence has been limited to "one to 10 amino acids," a new search for this newly added limitation is required.

**[4]** Applicant's arguments in the amendment filed on 12/15/2005 have been fully considered. However, in view of the non-entry of the amendment, applicant's arguments are not found persuasive to overcome the outstanding rejection(s) as set forth in the Office action mailed on 9/16/2005 for the reasons of record stated therein.

**[5]** Even if the amendment filed on 12/15/2005 were entered, the rejections under 35 U.S.C. §§ 112, first paragraph, as set forth at ¶¶ [11] and [12] of the 9/16/2005 Office action would be maintained for the reasons of record.

**[6]** In view of the non-entry of the amendment, the claim status is as follows:

Claims 1-2, 5, 7-10, and 12-31 are pending.

Claims 14-15, 18-19, and 22-25 are withdrawn from consideration.

Claims 1-2, 5, 7-10, 12-13, 16-17, 20-21, and 26-31 are rejected.

No claim is in condition for allowance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Steadman whose telephone number is 571-272-0942. The examiner can normally be reached on Mon to Thurs, 6:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Kerr can be reached on 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David J. Steadman, Ph.D.

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Primary Examiner  
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